

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 15, 26, 29 and 33-47 are pending after entry of the amendments set forth herein.

Claims 15, 26, 29, 33 and 34 were examined. Claims 15, 26, 29 and 33 were rejected. Claim 34 was objected to.

Applicant respectfully requests reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

**The Office Action**

In the Official Action of December 30, 2003, the Examiner rejected claims 15 and 29 under 35 U.S.C. Section 112, second paragraph as being indefinite. With regard to claim 15, the Examiner asserted that it is unclear as to how suction connection one thing to another and how suction has a cross-sectional area. In response thereto, Applicant has amended claim 15 to replace suction with suction conduit. With regard to claim 29, the Examiner asserted that ports were not a sufficiently structural limitation to the claim. Applicant disagrees, since the structure of the ports is clearly shown in the figures and described in the specification. Nevertheless, in order to advance the prosecution of the instant application, Applicant has amended claim 29 to further recite a contact member in which the ports of the suction arrangement are formed.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 15 and 29 under 35 U.S.C. Section 112, second paragraph as being indefinite, as being no longer appropriate.

Claims 15, 26, 29 and 33 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Nishiguchi et al., U.S. Patent No. 4,904,012. The Examiner asserted that Nishiguchi et al. shows a suction paddle having a plurality of suction ports. With regard to suction apertures, the Examiner concluded that since Applicant has not stated that the relative sizes of the elements solves a state problem or are for a specific reason, that these features would have been a matter of "mere design choice".

Applicant respectfully traverses this ground of rejection. With regard to claim 15, a surgical instrument is being claimed. Nishiguchi et al. does not disclose a surgical instrument, but rather a

suction paddle for handling a semiconductor device. Nor is there any suggestion or teaching by Nishiguchi et al. that such device would or could be used as a surgical device. Wafers are generally at least eight inches in diameter, currently many are twelve inches. The paddle configuration of Nishiguchi et al. would be much too large for proper engagement with the heart, not to mention that it is not described as being made of medical grade materials.

Further, Nishiguchi et al. fails to disclose or suggest suction apertures, as the Examiner has so much as admitted. There is no teaching or motivation provided by Nishiguchi et al. or any of the other art of record which would lead one of ordinary skill in the art to “choose to design” suction apertures into the arrangement of Nishiguchi et al. The Examiner’s conclusion is clearly based on hindsight reasoning, the hindsight gained from reading the present disclosure and claims, which is inappropriate. As such, the Examiner has failed to set forth a *prima facie* case of obviousness with respect to all of the claims in this case.

Further, with regard to claim 26, the device of Nishiguchi et al. is not configured to engage the surface of the heart for reasons described above. With regard to claim 29, the suction arrangement of Nishiguchi et al. is not for a surgical instrument adapted for fixation of a portion of a beating heart.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 15, 26, 29 and 33 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Nishiguchi et al., U.S. Patent No. 4,904,012, as being inappropriate.

Applicant wishes to extend his thanks to the Examiner for the indicated allowability of the subject matter recited in claim 34. Applicant has submitted new claim 36 which incorporates the recitations of claim 34 and claim 26, from which claim 34 had depended. Claim 34 has been amended to depend from claim 15, to avoid redundancy.

It is respectfully submitted that new claims 35 and 37-47 are allowable over the art of record for at least the reasons provided above. Further, claims 37-40 recite that the suction apertures are oriented off-center to a circumference of the suction port with which each connects, a feature which is clearly neither disclosed nor suggested by Nishiguchi et al. Claims 41 and 43 recited that the suction ports are aligned in an (or two) array(s). This is also clearly not disclosed or suggested by Nishiguchi et al. Claim 42 recites a pair of contact members each having a plurality of ports and apertures, which is also lacking in Nishiguchi et al.

Accordingly, it is respectfully submitted that all newly submitted claims are allowable over Nishiguchi et al. and all of the art of record.

**Conclusion**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-003CON3.

Respectfully submitted,

LAW OFFICE OF ALAN W. CANNON

Date: \_\_\_\_\_

*March 30, 2004*

By: \_\_\_\_\_

*[Signature]*

Alan W. Cannon

Registration No. 34,977

LAW OFFICE OF ALAN W. CANNON  
834 South Wolfe Road  
Sunnyvale, CA 94086  
Telephone: (408) 736-3554  
Facsimile: (408) 736-3564